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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,348	04/06/2007	Christian Funke	2400.0430000/RWE/PDL	4992

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EXAMINER	
PAK, JOHN D	

ART UNIT	PAPER NUMBER
1616	

MAIL DATE	DELIVERY MODE
01/03/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/581,348	FUNKE ET AL.	
	Examiner	Art Unit	
	John Pak	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 December 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4 and 6-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4, 6-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *2/07,6/07,9/10*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Claims 1-4, 6-19 are pending in this application.

Applicant's election with traverse of the invention of Group VI and compound I-1-4 as the single disclosed species of formula I and fipronil as the single disclosed species of the second insecticide, in the response filed on 12/15/2010, is acknowledged.

The traversal is based on the argument that all inventions share the features of a composition comprising an anthranilamide of Formula I and at least one insecticide. This is not the standard by which lack of unity is determined. The correct standard has been applied and fully explained in the Office action of 11/15/2010. Applicant also cites MPEP 1850 for the position that the claims do not qualify as a "clear case" of lacking unity of invention. The Examiner cannot agree. In the very same MPEP 1850 that applicant relies on, the same fact situation as in this application is clearly stated as lacking unity of invention:

> to all claims. In the case of independent claims to A + X and A + Y, unity of invention is present *a priori* as A is common to both claims. However, if it can be established that A is known, there is lack of unity *a posteriori*, since A (be it a single feature or a group of features) is not a technical feature that defines a contribution over the prior art.

See also from MPEP 1850:

> Alternative forms of an invention may be claimed either in a plurality of independent claims, or in a single claim. In the latter case, the presence of the independent alternatives may not be immediately apparent. In either case, however, the same criteria should be applied in deciding whether there is unity of invention. Accordingly, lack of unity of invention may exist within a single claim. Where the claim contains distinct embodiments that are not linked by a single general inventive concept, the objection as to lack of unity of invention should be raised. PCT Rule 13.3 does not prevent an Authority from objecting to alternatives being contained within a single claim on the basis of considerations such as clarity, the conciseness of claims or the claims fee system applicable in that Authority.

For these reasons, applicant's traversal is found unpersuasive. Claims 1-4 and 6-19 will presently be examined to the extent that they read on the elected subject matter.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4 and 6-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 03/015518.

WO 03/015518 discloses a genus of pesticidal anthranilamides (pages 1-4), which includes the elected species (Example 11 on page 42; page 115, compound 531; see compound 531 in Tests A to H, K, M, P, Q, R on pages 127-138). It is noted for the record that this species has a common name, chlorantraniliprole. Various formulations are disclosed with diluents and surfactants (pages 89-90). Activity against a broad spectrum of pests is disclosed, including mosquitoes, black flies, biting midges, ants,

lice, fleas and many others (see e.g., page 93, lines 36-38; page 94, lines 2-25). Combination with fipronil, a "most preferred" combination partner, is disclosed (page 96, line 37; page 98, lines 5, 18; claim 9). Various concentrations and rates of application are disclosed (page 99).

The difference between the claimed invention and WO 03/015518 is that although WO 03/015518 discloses and claims mixtures of anthranilamides that include chlorantraniliprole + fipronil, the specific mixture of chlorantraniliprole + fipronil is not expressly disclosed. However, given the excellent activity of chlorantraniliprole and the well known good activity of fipronil, one having ordinary skill in the art would have been motivated to follow the teachings of WO 03/015518 to arrive at the claimed combination of two active ingredients.

Applicant's specification data has been reviewed in this regard but the elected species combination were not tested. The tested formula compound has a 3-CF_3 instead of the 3-Br of the elected species and has an extra methyl group on the amide group on the 6-position of the phenyl ring. Further, the results show only low rates were tested – in other words, only rates at which the known active pesticides did not kill were tested. Thus, the data is very limited and it cannot be determined whether similar data would be obtained when the known pesticides are used at their known active concentrations. Evidence of nonobviousness, if any, must be commensurate in scope with that of the claimed subject matter. In re Kulling, 14 USPQ2d 1056, 1058 (Fed. Cir. 1990); In re Lindner, 173 USPQ 356, 358 (CCPA 1972).

Therefore, the claimed invention, as a whole, would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention and the claimed invention as a whole have been fairly disclosed or suggested by the teachings of the cited reference.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOHN PAK whose telephone number is **(571)272-0620.** The Examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's SPE, Johann Richter, can be reached on **(571)272-0646**.

The fax phone number for the organization where this application or proceeding is assigned is **(571)273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/John Pak/
Primary Examiner, Art Unit 1616